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Paper No.

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MAILED
MAR 31 2011
OFFICE OF PETITIONS

In re Patent No. 5,968,067 :
Issue Date: 10/19/1999 :
Application Number: 09/123,277 : LETTER DISMISSING PETITION
Filing Date: 07/28/1998 :
For: SURGICAL PENILE DILATOR :
INSTRUMENT AND METHOD FOR ITS :
USE :

This is a decision in reference to the paper filed on February 14, 2011, styled as a renewed petition under 37 CFR 1.377, to review the prior refusal of the PTO to accept and record a timely maintenance fee payment for the above-identified patent.

The petition is **dismissed**.

The patent issued on October 19, 1999. The first and second maintenance fees were timely paid. The window for payment of the third maintenance fee opened on October 19, 2010. The maintenance fee may be paid until April 19, 2011, or, with a surcharge for late payment, from April 20, 2011 through October 19, 2011.

At the outset, the papers are not properly signed. 37 CFR 1.33(b) states that amendments and other papers filed in an application must be signed by a patent practitioner or all of the applicants for patent. The subject petition is unsigned, and the cover letter is signed only by joint inventor Michael Mooreville. A renewed petition signed by all joint inventors is required to be filed if reconsideration is requested.

Specifically, the unsigned paper filed with the petition states:

I received a notification letter to pay the maintenance fee on my patent on 11/23/09, which I paid on 01/05/10, but I did not pay attention to the patent number, and I just realized that your letter to me had my name attached to the wrong patent (5,740,805). Please correct your error and apply the payment to the right patent (5,968,067). I am including proof of payment, your letter with the wrong patent number, and the previous maintenance fee reminder from 2003.

A grantable petition under 37 CFR 1.377 to accept and record a maintenance fee requires:

- (1) submission of the petition be submitted within two months of the action complained of;
- (2) payment of the petition fee;
- (3) proof that the maintenance fee, and any applicable surcharge, was received in the Office prior to the date of patent expiration, and
- (4) proof that proper identification of the patent and application numbers under 37 CFR 1.366(c) was submitted with the maintenance fee payment.

The petition lacks item (4).

In regards to item (4), the showing of record does not indicate that at least one mandatory identifier was correct as required by 37 CFR 1.366(c).

As stated in MPEP 2580:

A petition under 37 CFR 1.377 would not be appropriate where there is a complete failure to include at least one correct mandatory identifier as required by 37 CFR 1.366(c) for the patent since no evidence would be present as to the patent on which the maintenance fee was intended to be paid. If the maintenance fee payment with an incorrect mandatory identifier was made near the end of the grace period, the patent might expire since the Office would not credit the fee to the patent. A petition under 37 CFR 1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number. Likewise, a petition under 37 CFR 1.377 would not be appropriate where the entire maintenance fee

payment, including any necessary surcharge, was not filed prior to expiration of the patent.

Further, with regards to the request for refund, 37 CFR 1.26(a) states that:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

MPEP 607.02 states, in pertinent part that:

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment).

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).

The showing of record is that the USPTO mailed a Maintenance Fee Reminder on November 23, 1999, to petitioner Michael Mooreville listing his address as that of record for U.S. Patent No. 5,740,805, and stating that the 12 year maintenance fee payment was due for that patent. While it is regrettable that the subject Maintenance Fee Reminder appears to have been mailed in error to the subject address, 37 CFR 1.377 nonetheless requires proof that the mandatory identifiers (patent number and application number) for the patent which petitioner intended to maintain in force, were included with the maintenance fee payment. In the absence of said identifiers, the showing of record is that petitioner intended to pay the maintenance fee for

the patent listed which was maintained in force (i.e., Patent No. 5,740,805). Simply put, it is the patentee's responsibility to verify that the payment is directed to the patent number and application number for the patent which patentee actually intends to maintain in force. In the absence of such information (the mandatory identifiers as specified above), the Office cannot conclude that, based on the information present at the time the maintenance fee payment was received, the patent to which the payment was applied, (i.e., U.S. Patent No. 5,740,805) was not the patent which petitioner intended to maintain in force, or that the maintenance fee was applied to the aforementioned patent in error.

As such, the request for a refund of the maintenance fee is dismissed.

Any renewed petition should be submitted within **TWO (2) MONTHS** to be considered timely.

The address in the petition is different than the correspondence address. A courtesy copy of this decision is being mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address (copy enclosed) should be completed and returned if the correspondence address need to be updated.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition,
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

A reply may also be filed via the EFS-Web system of the USPTO.

Patent No. 5,968,067

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/123

Cf: MICHAEL MOOREVILLE, MD
287 SYCAMORE AVENUE
MERION STATION PA 19066

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CHANGE OF CORRESPONDENCE ADDRESS

Patent

Address to:
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Patent Number

Issue Date

Application Number

Filing Date

First Named Inventor

Attorney Docket
Number

Please change the Correspondence Address for the above-identified patent to:

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This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

This form will not affect any "fee address" provided for the above-identified patent. To change a "fee address" use the "Fee Address Indication Form" (PTO/SB/47).

I am the:

- ☐ Patentee.
- ☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).
- ☐ Attorney or agent of record. Registration Number _____.

Signature

Typed or
Printed Name

Date

Telephone

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.